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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,545	12/18/1998	THOMAS HAROLD ROESSLER	14.541	9533

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EXAMINER	
REICHLE, KARIN M	
ART UNIT	PAPER NUMBER
3761	24

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N. K.

Office Action Summary	Application No.	Applicant(s)	
	09/216,545	ROESSLER ET AL.	
	Examiner	Art Unit	
	Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 December 1998* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *18 December 2002* is: a)☐ approved b)☒ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *22* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-18-02 has been entered.

2. The clean copy of the Summary of the Invention and the marked up copies of the paragraphs on pages 26 and 27 were not in compliance with 37 CFR 1.121. The Examiner has made the appropriate changes to such in red ink to bring them into compliance.

3. The abstract of the disclosure is objected to because the abstract is to long, i.e must be no more than 150 words in length for printing purposes. Also on lines 5 and 7, "each of" should be deleted. Correction is required. See MPEP § 608.01(b).

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 12-18-02 have been disapproved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

The proposed changes to Figure 4 are not approved because the Figure does not accurately depict the method set forth on page 21, line 4-page 25, last line, e.g. where are 78 and 76 prior to rollers 106 and 108? Where are the seams 74 created?

4. The drawings are objected to because Figure 4 and the description on page 21, line 4-page 25, last line are inconsistent, see discussion supra and infra. In Figure 4, where are 74, 76 and 78?

See especially page 23, paragraph at line 15, last two sentences, page 24, paragraph at line 28, first sentence thereof, page 25, paragraph at line 8, first two sentences thereof and page 25, lines 32-34. In Figures 1-3, 54 and 58 are denoted inconsistently, i.e. are they underlying structure or not? If so, the lines extending from the numerals in Figures 1 and 3 should be dashed. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities: In the Summary of the Invention section, page 22 of the amendment, line 1, "are" should be --is--, on line 5, "panels" should be --panel-- and "edges" should be --edge--. In the paragraph on page 21, line 33, on the third to last line thereof, after "engaged", --(not shown)-- should be inserted and on the last line "(not shown)" should be deleted. As already discussed above, Figure 4 and the description on pages 22-25 are inconsistent.

Appropriate correction is required.

6. Claims 32-52 are objected to because of the following informalities: in claim 32, lines 9 and 11, "edge" should be --edges--. This also applies to similar language in claim 40. Additionally in claim 40, subsection e), first two lines "said front panels to said side edges" should be --each front panel to said respective side edge--. In claim 49, subsection f), line 1, "front panels and back panels" should be --front panel and said back panel on each side edge of each of the absorbent chassis--. Appropriate correction is required.

7. Claims 35, 42, and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 35, 42 and 51, are the fasteners on the panels both hook and loop fasteners? Isn't the exterior surface of the chassis one of the hook or loop and the fasteners are the other? In claim 49, sections b) and c) are internally inconsistent, i.e "back" panels are connected to back region and "front" panels are connected to the front portion?

8. Applicant's remarks on pages 6-8 have been considered but are either deemed moot in that the issue has not been reraised or is deemed nonpersuasive for the reasons set forth supra.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 32-38 and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by SCA '290.

See Figures; page 9, lines 17-20; page 5, lines 9-11, the absorbent chassis; elements 28 and 4, page 7, lines 18-24, page 11, lines 11-15, the elastic back panel 13; page 5, line 19-page 6, line 10, page 7, lines 6-7, page 11, lines 11-15, elastic front panel 8 and separate 5 or unitary engaging portions; page 10, lines 10-11, the seam 17. With regard to claims 26-28, such claims are product by process claims. In accord with MPEP 2113, even though the SCA product was made by a different process, since the end product is the same as the end product of claims 26-28, the claims do not distinguish over SCA.

12. Claims 40-48 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCA '290 in view of McNichols '805.

The SCA device, see preceding rejection, includes all the claimed structure except for the releasable bond as set forth in subsection e) of claim 40 and the specifics thereof in the dependent claims 46-48 and 52. However, McNichols teaches a similar device which also includes a releasable bond to improve reliability of maintaining the article in a prefastened condition particularly when it is being pulled on or off the hips, i.e. to maintain the shape of and put on like

a pair of ordinary underpants, see col. 15, line 9- col. 16, line 19 of McNichols. To employ a releasable bond as taught by McNichols on the SCA device would be obvious to one of ordinary skill in the art in view of the recognition that such would improve the reliability of maintaining the prefastened condition during use and the desirability of such by SCA, attention is reinvited to page 9, lines 17-20 of SCA.

13. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over SCA '290 in view of McNichols '805 and Sauer '428.

The claim requires panels of neck-bonded laminate which SCA does not teach. SCA teaches panels of nonwoven or/and elastic material. See McNichols, col. 13, lines 15-30, and Sauer, col. 8, lines 13 et seq, which teach it is well known to form side panels of nonwoven or/and elastic neck-bonded laminate material. To make the side panels of neck-bonded laminate material on the SCA device would be obvious to one of ordinary skill in the art in view of the interchangeability or in view of the well known use of such material for side panels both of which are taught by McNichols and Sauer.

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 32, 34-35, 37, 40, 42, 44, 47-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21, 23-27 of U.S. Patent No. 6, 113,717 in view of SCA '290. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the application and patent were filed on the same day the one way In re Vogel test applies, i.e. are the application claims obvious in view of the patent claims? The answer is yes because the absorbent article produced by the method of the patent claims necessarily and inevitably includes the structure claimed in the application claims except for the panels being elastic. However see cited portions of SCA supra. To make the nonelastic panels of the patent elastic instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by SCA.

16. Claims 32, 34-35, 37, 40, 42, 44, 47-52 are directed to an invention not patentably distinct from claims 21, 23-27 of commonly assigned 6,113,717. Specifically, see preceding rejection, paragraph 15.

17. Claims 32, 34, 37, 40, 47, 49-50 and 52 are directed to an invention not patentably distinct from claims 14-16 and 21-22 of commonly assigned 09/706, 294. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '294 claims only further include fastener edge lengths and releasable joint lengths in addition to the structure claimed in the instant application and it is well settled that omission of a feature, i.e. the lengths, in a combination is an obvious expedient if the remaining features perform the same function as before, In re Karlson, 136 USPQ 184 (CCPA 1963).

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 09/706,294, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

18. Applicant's remarks with regard to the prior art on pages 9-13 have been carefully considered but are either deemed moot, i.e. the double patenting rejection on 706,294, in that the issue has not been reraised or is deemed nonpersuasive for the reasons set forth supra. It is noted the cited portions of Fernfors teach elastic panels, e.g. page 11 thereof, and while McNichols may have been commonly assigned at the time the invention was made, Applicants have not provided the statement evidencing common ownership as set forth in MPEP 706.02(1)(2) nor is there evidence otherwise provided, i.e. while the instant application includes a copy of the assignment of the instant application, and the reel number and frame number of the 6-19-98 assignment of the McNichols application, this does not evidence that they were commonly assigned at the time the invention was made, i.e. on 12-18-98.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The '797 patent was one of the applications cited in an earlier IDS. The other patents show prefastening and refastening capabilities.

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20. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFAX number is 703-872-9302.

K. M. Reichle

KARIN REICHLE
PATENT EXAMINER

KMR

March 31, 2002